Remarks

In this Amendment, Applicant has amended claims 1, 5-9, 14, 19, 21-22, and 30 and cancelled claims 4 and 17. No new matter has been added.

In the Office Action, the Examiner stated that Claims 28 and 36 were objected to because it was "not clear from the claim language how these claims are further limiting the claims which they are dependent from, claims 27 and 35, respectively." These claims require that there be a determination of the primary carrier. This is a known term in the art, and has utility in determining which carrier is initially responsible to the provider for payment.

Claims 22-37 were rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter. Specifically, the Examiner asserted that:

> 6. In the present case, claims 22-37 recite abstract ideas. The recited steps of merely determining insurance eligibility information for consumers does not apply, involve, use, or advance the technological arts since all of the recited steps can be performed manually by a user. For example, a user could receive a paper list and determine insurance eligibility by simply calling (via telephone) the insurance companies to determine insurance eligibility. The calls could be answered (on the other end of the line) by a computerized system in which the user could enter a patient's name and/or identification to determine insurance eligibility.
>
> 7. Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. Although the recited process produces a useful, concrete, and tangible result, since the claimed invention, as a whole, is not within the technological arts as explained above, claim I is deemed to be directed to non-statutory subject matter.

> Claims 22-37 do not recite abstract ideas, but rather recite a method of doing business. Such claims are clearly statutory subject matter (site). The examiner had improperly construed 35 U.S.C. § 101 to require an advancement of the "technological arts". The examiner also construes the invention as not providing a useful, concrete, intangible result. This construction could not be further from the actual facts.

At this juncture, it may be useful to briefly review Applicant's invention. Applicant's invention is directed to a problem of extremely significant proportions in the United States and elsewhere. The problem is that the present medical insurance system covers millions of people, their relations, and their dependents. More than one insurance carrier can cover a single person or their dependent. The problem is compounded by erroneous or incomplete patient records throughout the system. In brief, medical providers do not know if the patient in their office is the person they say they are, if they are covered by any insurance, and if they are covered by more than one insurance carrier. The problem amounts to many, many millions of dollars of losses in the United States only, on an annual basis. The problem is real, it is expensive, and it is approaching a crisis in the United States. This invention poses a unique solution to this problem.

The invention approaches the problem by first verifying that the person is who they say they are. This is done by retrieving demographic information, which can be from a variety of sources. These sources can include credit information, medical information, or public record information. The information can include the social security number, provider number, date of birth, relationship code match database, credit

bureaus, utilities, driver's license databases, property databases, name change database and the like, to crosscheck and verify the identity of the patient. The invention does not rely on the provision of a card or a social security number by the patient, but instead the system verifies the identity of the patient using any or all of these various third party sources. Next, the eligibility of the patient is determined by searching eligibility information for at least 2 insurance carriers. This is a critical step in the process, since the more insurance carriers that are searched, the more accurate the results will be for the patient, and for the provider. For example, if the information of more than one medical insurance carrier indicates that the patient is eligible, it may be an indication that one insurance carrier is responsible for the procedure, and not the other. It may further indicate that one of the insurance carriers has outdated or erroneous information. Finally, it may be an indication that the patient is providing incorrect information. Only by searching a variety of carriers, and not just the carrier that the patient may indicate, can accurate information be retrieved to avoid billing irregularities later in the process. The invention solves a real problem of great magnitude, it has utility as a method of doing business and is well within statutory subject matter.

Claims 22-28 and 30-36 were rejected under 35 U.S.C. § 102(b) as being anticipated by Doyle (U.S. 5,070,452). The Examiner asserted that:

> Doyle is directed towards a computerized medical insurance system including means to automatically update member eligibility files at pre-established intervals.

As per claim 22, which is directed towards a method of determining insurance eligibility information for consumers, Doyle teaches the steps of receiving a lost of one or more consumers (Col. 2, Ln. 42-64, Col. *5*, Ln. 16-32 and Col. *5*, Ln. *5* 1-64), querying at least one of a plurality of network locations specifying insurance eligibility information to determine whether one or more consumers is insured by the insurance carrier (Figure 2B), and indicating which of the consumer of the list have insurance (Figure 2B and Col. *5*, Ln. 16-32).

As per claim 23, in Doyle the network locations are insurance company carrier systems (Col. 2, Ln. *45-48)*.

As per claim 24, in the system of Doyle, for the consumers having insurance, the system specifies which insurance carrier provides insurance for the consumer (Col. 2, Ln. 42-64 and Col. *5*, Ln. 16-32).

As per claim *25*, the system of Doyle determines that at least one of the consumers is insured by two or more insurance carriers (Col. 2, Ln. 16-32).

As per claims 26-28, Doyle fails to teach, per se, the concept of specifying which insurance carriers provide insurance and which carrier is a primary carrier. However Doyle does teach that the insurance administration database contains a listing of the dollar amounts payable for a given type of diagnosis (Col. 2, Ln. 59-64). The examiner takes the position that from this information in Doyle the user can determine which insurance carrier is the primary carrier (assuming the primary carrier while contain the highest dollar amounts payable of all the insurance carriers.

As per claim 30, which is directed towards a machine readable storage medium with a plurality of code sections, Doyle teaches the steps of receiving a lost of one or more consumers (Col. 2, Ln. 42-64, Col. *5*, Ln. 16-32 and Col. *5*, Ln. *5* 1-64), querying at least one of a plurality of network locations specifying insurance eligibility information to determine whether one or more consumers is insured by the insurance carrier (Figure 2B), and indicating which of the consumer of the list have insurance (Figure 2B and Col. *5*, Ln. 16-32).

As per claim 31, in Doyle the network locations are insurance company carrier systems (Col. 2, Ln. *45-48).*

As per claim 32, in the system of Doyle, for the consumers having insurance, the system specifies which insurance carrier provides insurance for the consumer (Col. 2, Ln. 42-64 and Col. *5,* Ln. 16-32).

As per claim 33, the system of Doyle determines that at least one of the consumers is insured by two or more insurance carriers (Col. 2, Ln. 16-32).

As per claims 34-36, Doyle does not explicitly recite, per se the concept of specifying which insurance carriers provide insurance and which carrier is a primary carrier. However, Doyle does teach that the insurance administration database contains a listing of the dollar amounts payable for a given type of diagnosis (Col. 2, Ln. *5* 9-64). The examiner takes the position that from this information in Doyle the user can determine which insurance carrier is the primary carrier (assuming the primary carrier while contain the highest dollar amounts payable of all the insurance carriers.

Doyle does at all disclose or suggest applicant's invention. Doyle is directed to a system by which it can be determined which type of coverage from a single insurance carrier a patient may have. Doyle, column 2, lines 42-64. Doyle does not address the problem of multiple insurance carriers, and possible erroneous medical insurance information provided by those carriers or by the patient. Further, Doyle does not at all address the independent verification of the identify of the patient from various third party sources. Doyle accordingly does not suggest a solution to the above-noted medical insurance crisis.

Claims 1-5, 7, 14-18 and 20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Satoh (U.S. 5,774,671) in view of Szlam (US 5,675,637). The Examiner asserted that:

> Satoh is directed towards a service changeable system at an information center while Szlam is directed towards a method for automatically obtaining and presenting data from multiple data sources,
>
> As per claim 1, which is directed towards a method for collecting and providing consumer information to a user, Satoh teaches the steps of receiving from a requesting computer a request for consumer information from a user (the request identifying a customer) and retrieving the requested consumer information corresponding to the identified consumer from at least one network location (the consumer information comprises at least one data item) (Col. 1, Ln. 59-Col. 2, Ln. 13 and Col. *5*, Ln. 65-Col. 6, Ln. 17).
>
> Satoh fails to teach the step of transferring at least one data item from the retrieved consumer information to a corresponding field in a user interface in a requesting computer (screen scraping). However this feature is well-known in the art as evidenced by Szlam (Col. 12, Ln. 4-28 and Col. 17, Ln. 53-Col. 18, Ln. *5)*. At the time the invention was made, it would have been obvious to one of ordinary skill in the art to have included this screen-scraping feature as taught in Szlam in order to have provided the user with a method for consolidating multiple sources of information located on various screens as recited in Szlam (Col. *5*, Ln. 25-Col. 6, Ln. 18).
>
> As per claim 2, in Satoh the user is authenticated (Col. 4, Ln. 3 1-39).
>
> As per claim 3, in Satoh the user information comprises demographic information (Figure 8 and Col. 4, Ln. 32-42).
>
> As per claims *4-5*, in Satoh the user is provided information regarding services (Col. 1, Ln. *59-Col.* 2, Ln. 13) and the examiner takes the position that it is within the scope of Satoh that these services include consumer insurance and credit card information.

As per claim 7, the combined system of Satoh in view of Szlam uses screen scraping technology as noted in the rejection of claim 1.

As per claim 14, which is directed towards a machine readable storage medium, Satoh teaches the steps of receiving from a requesting computer a request for consumer information from a user (the request identifying a customer) and retrieving the requested consumer information corresponding to the identified consumer from at least one network location (the consumer information comprises at least one data item) (Col 1, Ln. 59-Col. 2, Ln. 13 and Col. 5, Ln. 65-Col. 6, Ln. 17).

Satoh fails to teach the step of transferring at least one data item from the retrieved consumer information to a corresponding field in a user interface in a requesting computer (screen scraping). However this feature is well known in the art as evidenced by Szlam (Col. 12, Ln. 4-28 and Col. 17, Ln. 53-Col. 18, Ln. 5). At the time the invention was made, it would have been obvious to one of ordinary skill in the art to have included this screen-scraping feature as taught in Szlam in order to have provided the user with a method for consolidating multiple sources of information located on various screens as recited in Szlam (Col. 5, Ln. 25-Col. 6, Ln. 18).

As per claim 15, in Satoh the user is authenticated (Col. 4, Ln. 3 1-39).

As per claim 16, in Satoh the user information comprises demographic information (Figure 8 and Col. 4, Ln. 32-42).

As per claims 17-18, in Satoh the user is provided information regarding services (Col. 1, Ln. 59-Col. 2, Ln. 13) and the examiner takes the position that it is within the scope of Satoh that these services include consumer insurance and credit card information.

As per claim 20, the combined system of Satoh in view of Szlam uses screen scraping technology as noted in the rejection of claim 1.

Satoh discloses a service changeable system at an information center for tailoring service requests to the preferences of the user. This system does not at all disclose or suggest Applicant's invention. Satoh, et al. merely configure applications for the user, or deny the applications based on the user preferences. There is no suggestion at all of determining medical insurance eligibility from at least two insurance carriers. Further, there is no suggestion of verification of a medical consumer for that medical insurance. Satoh, et al. does not disclose or suggest Applicant's invention.

Szlam similarly does not disclose or suggest Applicant's invention. Szlam, et al. discloses a method for automatically obtaining and presenting data from multiple data sources. An agent workstation receives an initial information item and sends this item to the specified information sources. Information is received from the sources, and displays or presents the information received. If the information is not adequate, the information from one source may be used to obtain information from another source. There is nothing in this patent to suggest the determination of medical insurance eligibility by querying insurance information for at least two insurance carriers. There is further no suggestion of verifying a patient's identity to receive benefits under the determined insurance eligibility. Accordingly, the combination of Szlam and Satoh fail to disclose or suggest applicant's invention.

Claim 6 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Satoh and Szlam as applied to claim 1 above, and further in view of Spencer (U.S. 6,349,299). The Examiner stated that:

> Satoh and Szlam fail to teach the step of presenting the retrieved consumer information to the user for verification; however, this feature is well known in the art as evidenced by Spencer (Col. 10, Ln. 12-27). At the time the invention was made one of ordinary skill in the art would have been motivated to have included this user verification feature in the system of Satoh and Szlam, as taught in Spencer, in order to provide an additional level of security and to prevent unauthorized access.

Spencer (U.S. 6,349,299) discloses a system and method for storing electronic contact information in an address book. It is not directed to the provision of medical insurance information. As discussed above, Szlam similarly is not directed to the determination of medical insurance eligibility for more than one insurance carrier, and the verification of a patient to receive such insurance. Accordingly, the combination of Spencer and Szlam fail to disclose or suggest applicant's invention.

Claims 9-13 were rejected under 35 U.S.C. § 103(a) as being unpatentable over McNeil (U.S. 4,876,643). The Examiner indicated that:

> McNeil is directed towards a parallel searching system having a master processor for controlling plural slave processors for independently processing respective search requests.
>
> As per claims 9-13, which are directed towards a system for collecting and providing consumer information to a user, McNeil teaches a buffer for receiving a user request for information from a requesting computer and for receiving consumer from a specified network location. McNeil also teaches an information matching system for retrieving the consumer information

> and a transfer agent (bus) for transferring at least one item of the consumer information in the retrieved consumer information to a corresponding field in a user interface in the requesting computer (Abstract and Col. 3, Ln. *35-50)*.
>
> McNeil does not expressly teach the specific data recited in claims 9-13; however, these differences are only found in the non-functional descriptive material and are not functionally involved in the steps recited nor do they alter the recited structural elements. The recited method steps would be performed the same regardless of the specific data. Further, the structural elements remain the same regardless of the specific data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983);In re Lowry, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP § 2106.*

McNeil et al. are directed to parallel searching system having a master processor for controlling plural slave processors for independently processing respective search requests. McNeil is not at all directed to solving the problem at hand, namely, the verification of a patient for medical insurance from multiple insurers, and the determination of medical insurance eligibility. Secor et al. is directed to a method and system for network event impact analysis and correlation with network administrators, management policies and procedures. The patent is not directed to solving the medical insurance eligibility crisis, the verification of patients for that insurance. Accordingly, Secor adds little to the patents cited in the above-identified references.

Claim 19 was rejected under 35 U.S.C. § 103(a).

> Satoh and Szlam fail to teach the step of presenting the retrieved consumer information to the user for verification; however, this feature is well known in the art as evidenced by Spencer (Col. 10, Ln. 12-27). At the time the invention was made one of ordinary skill in the art would have been motivated to have included this user verification feature in the system of Satoh and Szlam, as taught in Spencer, in order to provide an additional level of security and to prevent unauthorized access. .

Claim 8 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Satoh in view of Spencer and Szlam. The Examiner stated that:

> Claim 8 is directed towards a method for collecting and providing consumer demographic information and consumer insurance information to a user.
>
> Satoh teaches the steps of a) receiving from a requesting computer a request for consumer information from a user (the request identifying a customer) and b) retrieving the requested consumer information corresponding to the identified consumer from at least one network location (the consumer information comprises at least one data item) (Col. 1, Ln. 59-Col. 2, Ln. 13 and Col. *5*, Ln. *65-Col.* 6, Ln. 17).
>
> Satoh fails to teach the step of c) presenting the retrieved consumer information to the user for verification; however, this feature is well known in the art as evidenced by Spencer (Col. 10, Ln. 12-27). In Spencer, once the user verifies the information the record is created and stored in the desired database. At the time the invention was made one of ordinary skill in the art would have been motivated to have included this user verification feature in the system of Satoh, as taught in Spencer, in order to provide an additional level of security and to prevent unauthorized access.
>
> Satoh teaches the step of d) receiving from a requesting computer a request for information from a user (the request identifying a consumer) and e) retrieving the requested consumer information corresponding to the identified consumer from at least one network location (the consumer information comprising at least one data item) (Col. 3, Ln. 50-Col. 4, Ln. 19 and Col. 17, Ln. 63-Col. 18, Ln. *5).*

Satoh the user is provided information regarding services (Col. 1, Ln. *59-Col.* 2, Ln. 13) and the examiner takes the position that it is within the scope of Satoh that these services include consumer insurance and credit card information.

Satoh and Spencer fail to teach the step of f) transferring at least one data item from the retrieved consumer information to a corresponding field in a user interface in a requesting computer (screen scraping). (In Spencer, once the user has verified their demographic, information, the information is stored in a database (Col. 10, Ln. 23-27) but is not transferred to a field.) However this feature is well known in the art as evidenced by Szlam (Col. 12, Ln. 4-28 and Col. 17, Ln. 53-Col. 18, Ln. *5).* At the time the invention was made, it would have been obvious to one of ordinary skill in the art to have included this screen-scraping feature as taught in Szlam in order to have provided the user with a method for consolidating multiple sources of information located on various screens as recited in Szlam (Col. *5,* Ln. 25-Col. 6, Ln. 18).

Claim 21 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Satoh in view of Spencer and Szlam. The Examiner asserted that:

Claim 21 is directed towards a machine readable storage medium, having stored thereon a computer program having a plurality of code sections executable by a machine for causing the machine to perform several steps.

Satoh teaches the steps of a) receiving from a requesting computer a request for consumer information from a user (the request identifying a customer) and b) retrieving the requested consumer information corresponding to the identified consumer from at least one network location (the consumer information comprises at least one data item) (Col. 1, Ln. 59-Col. 2, Ln. 13 and Col. 5, Ln. 65-Col. 6, Ln. 17).

Satoh fails to teach the step of C) presenting the retrieved consumer information to the user for verification; however, this feature is well known in the art as evidenced by Spencer (Col. 10, Ln. 12-27). In Spencer, once the user verifies the information the record is created and stored in the

desired database. At the time the invention was made one of ordinary skill in the art would have been motivated to have included this user verification feature in the system of Satoh, as taught in Spencer, in order to provide an additional level of security and to prevent unauthorized access.

Satoh teaches the step of d) receiving from a requesting computer a request for information from a user (the request identifying a consumer) and e) retrieving the requested consumer information corresponding to the identified consumer from at least one network location (the consumer information comprising at least one data item) (Col. 3, Ln. 50-Col. 4, Ln. 19 and Col. 17, Ln. 63-Col. 18, Ln. *5).*

Satoh the user is provided information regarding services (Col. 1, Ln. 59-Col. 2, Ln. 13) and the examiner takes the position that it is within the scope of Satoh that these services include consumer insurance and credit card information.

Satoh and Spencer fail to teach the step off) transferring at least one data item from the retrieved consumer information to a corresponding field in a user interface in a requesting computer (screen scraping). (In Spencer, once the user has verified their demographic information, the information is stored' in a database (Col. 10, Ln. 23-27) but is not transferred to a field) However this feature is well known in the art as evidenced by Szlam (Col 12, Ln 4-28
and Col. 17, Ln. 53-Col. 18, Ln. *5).* At the time the invention was made, it would have been obvious to one of ordinary skill iii the art to have included this screen-scraping feature as taught in Szlam in order to have provided the user with a method for consolidating multiple sources of information located on various screens as recited in Szlam (Col. *5.* Ln. 25-Col. 6, Ln. 18).

Claim 29 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Doyle as applied to claim 22 above, and further in view of Secor (U.S. 6,694,362). The Examiner stated that:

Doyle fails to teach the step of determining that at least one item of supplemental consumer information for one or more consumers is missing

> from the list of consumers and querying at least one of a plurality of network locations specifying demographic information to locate at least one of the missing items of supplemental consumer information. However this feature is well known in the art as evidenced by Secor. Secor, which is directed towards a method and system for network impact analysis, teaches a feature which determines that data is missing and a feature known as an "Action Tree" is used to query the appropriate data source to locate the missing information (Col. 8, Ln. 3 1-38). At the time the invention was made one of ordinary skill in the art would have been motivated to add the "Action Tree" feature to the system of Doyle with the motivation of 1) ensuring that all supplemental consumer information on a given user was available to the system and 2) provide a means to obtain missing information in obtain a complete record (these reasons are recited in Secor) (Col. 8, Ln. 30-46).

Claim 37 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Doyle as applied to claim 30 above, and further in view of Secor. The Examiner asserted that:

> Doyle fails to teach the step of determining that at least one item of supplemental consumer information for one or more consumers is missing from the list of consumers and
> querying at least one of a plurality of network locations specifying demographic information to locate at least one of the missing items of supplemental consumer information. However this feature is well known in the art as evidenced by Secor. Secor, which is directed towards a method and system for network impact analysis, teaches a feature which determines that data is missing and a feature known as an "Action Tree" is used to query the appropriate data source to locate the missing information (Col. 8, Ln. 3 1-38). At the time the invention was made one of ordinary skill in the art would have been motivated to add the "Action Tree" feature to the system of Doyle with the motivation of 1) ensuring that all supplemental consumer information on a given user was available to the system and 2) provide a means to obtain missing information in obtain a complete record (these reasons are recited in Secor) (Col. 8, Ln. 30-46).

The above rejection of claims 8, 19, 21, 29 and 37 are improper as all of these references fail to disclose or suggest Applicant's system for verifying insurance eligibility by searching after information of at least two insurance carriers and as well as verifying patient identity. Applicant has made every effort to present claims which distinguish over the cited art, and it is believed that all claims are now in condition for allowance. However, the Examiner is invited to call the undersigned if it is believed that a telephonic interview would expedite the prosecution of the application to an allowance. The Commissioner for Patents is hereby authorized to charge the fee for a two month extension of time, as well as any other fees which may be due, to Deposit Account No. 50-0951.

Respectfully submitted,

Date: 3/7/05

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